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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
COPPOLA, JACOB C				
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/656,274

**Applicant(s)**

KATO, YOSHIKAZU

**Examiner**

JACOB C. COPPOLA

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 09 December 2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 November 2008 has been entered.

***Acknowledgements***

2. This action is in reply to the Request for Continued Examination ("RCE") filed on 29 December 2008, the Remarks/Arguments filed on 21 November 2008 ("08 Nov Remarks"), and the Amendments to the Claims filed on 21 November 2008 ("08 Nov Amendments").
3. Claims 1-5 and 7-9 are currently pending and have been examined.
4. This Office Action is given Paper No. 20090305. This Paper No. is for reference purposes only.

***Information Disclosure Statement***

5. The Information Disclosure Statement filed on 09 December 2008 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181 and its discussion of C.F.R. §1.75. Correction of the following is required:

- a. The “means for receiving” of claim 1;
- b. The “means for storing” of claim 1;
- c. The “means for managing” of claim 1;
- d. The “means for reading” of claim 1;
- e. The “means for arranging” of claim 1; and
- f. The “means for composing” of claim 1.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-5 and 7-9 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

9. Regarding claims 1 and 7:

- g. These claims recite computer programs *per se*. “Computer programs claimed as computer listings *per se*, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claims recite only

abstractions that are neither “things” nor “acts,” the claims are not within one of the four statutory classes of invention<sup>1</sup>. Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

h. Additionally, Applicant’s original specification expressly states “[t]he series of steps described above may be executed by suitably functioning hardware or by software.” Specification, p. 31, last line – p. 32, first line. Because the claimed “means” and “unit[s]” may be interpreted as software *per se*, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

i. Alternatively, the Examiner notes that using the broadest reasonable interpretation of “unit,” as noted below, the claimed “unit[s]” are interpreted as software only. Because the broadest reasonable interpretation of “unit” includes software *per se*, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

10. Regarding claim 4:

j. Based on Supreme Court precedent<sup>2</sup> and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc).

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<sup>1</sup>35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of matter. The latter three categories define “things” (or products) while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed).

<sup>2</sup>See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

- k. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.
  - l. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.
  - m. In this particular case, the claim fails prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. For example, the first method step recites “receiving at least one order corresponding to a genre,” but does not recite the particular apparatus performing the “receiving.” Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.
11. Regarding claim 5:
- n. This claim is directed to a computer readable storage medium. The medium stores non-functional descriptive data. Accordingly, the medium is not eligible for patent protection under 35 U.S.C. §101 (MPEP §2106). The claim must recite that the instructions are *executed* by the processor to perform the method steps.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

12. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-5 and 7-9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

14. Regarding claims 1-3:

o. The following claim elements are means-plus function limitations that invoke 35 U.S.C. §112, sixth paragraph:

- i. ordering means for receiving at least one order corresponding to a genre;
- ii. storing means for storing a plurality of content data corresponding to the at least one order;
- iii. managing means for managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre;
- iv. reading means for reading said plurality of content data from said storing means in response to an instruction;
- v. arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means; and

- vi. composing means for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display.
- p. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The Examiner has carefully searched the original specification and cannot determine the structure performing the recited functions.
- q. Applicant is required to:
  - vii. Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. §112, sixth paragraph; or
  - viii. Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter. See 35 U.S.C. §132(a).
- r. If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, Applicant is required to clarify the record by amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter. See 35 U.S.C. §132(a).



15. Regarding claims 4 and 5:

s. These claims recite “reading said plurality of content data... by said storing....”

These claims are indefinite because one of ordinary skill in the art would not understand how data is read by a “storing.”

16. Regarding claim 7:

t. This claim recites “arranging unit configured to arrange... data read by said reading unit, in accordance with said preference data....” This claim is indefinite because one of ordinary skill in the art could interpret the “in accordance” clause as applying to either the arranging function or the reading function.

17. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1, 3-5, 7, and 9, as understood by the Examiner, are rejected under 35 U.S.C.

§103(a) as being unpatentable over Kent (U.S. 2002/0040374 A1) (“Kent”), in view of Nii (U.S. 2002/0065730 A1) (“Nii”).

20. Regarding claims 1, 4, 5, and 7:

u. Kent discloses the limitations:

ix. *ordering means (server 13) for receiving at least one order corresponding to a genre (¶¶ 0035 and 0048);*

x. *storing means (content database 160) for storing a plurality of content data corresponding to the at least one order (¶ 0079);*

xi. *managing means (software program 100) for managing preference data by which to determine preferences based on previous orders (¶¶ 0062 and 0065-0068);*

xii. *reading means (optimization program 48) for reading said plurality of content data from said storing means in response to an instruction (¶ 0079);*

xiii. *arranging means (profiling program 132) for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means (¶ 0079); and*

xiv. *composing means (“printer”) for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display (¶ 0083).*

- v. Kent discloses orders corresponding to a genre (§§ 0048 and 0054). Kent does not directly disclose “preferences based on a quantity of previous orders, each order corresponding to a genre,” as recited in the claims.
  - w. Nii, however, discloses a method of and a system for distributing electronic content. In Nii’s method, preferences (“tailorization parameters”) based on a quantity of previous orders (“list of previous items purchased”), each order corresponding to a genre (all the content of Nii being purchased belongs to a genre, for example see § 0075), are used for “tailorization of the content to be delivered on a terminal per terminal basis,” where “information to be delivered to that particular terminal is tailored in accordance with the preferences, settings, etc.” (§ 0079). This ability of Nii demonstrates the ability of one of ordinary skill in the art to apply these teachings to similar systems, such as the system of Kent.
  - x. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the preference parameters of Nii for the preference parameters of Kent. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.
21. Regarding claims 3 and 9:
- y. Kent/Nii discloses the limitations of claim 1, as shown above. Kent/Nii, further, disclose the limitations:

xv. *wherein said plurality of content data include at least information for distinguishing said plurality of content data from other content data and information for indicating where said plurality of content data are stored in said storing means* (Kent, ¶¶ 0079 and 0099-0100).

22. Claims 2 and 8, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Kent/Nii, in further view of Official Notice.

23. Regarding claims 2 and 8:

z. Kent/Nii discloses the limitations of claim 1, as shown above. Kent/Nii, further, disclose the limitations:

xvi. *wherein said managing means determines said genre of said content data read by said reading means* (¶¶ 0065-0068: program **100** chooses relevant articles based on criteria, here the type of article must be determined; see also ¶ 0061: program **48** ensures content matches user's interests; ¶ 0078: prioritizing content based on user interests; and ¶¶ 0077 and 0079: program **48** and program **132** choose content that best relates to user profile).

aa. Kent/Nii does not directly disclose the managing means associates the number of times that the plurality of content data belonging to said genre have been read with information for identifying a user for management purposes.

bb. However, the Examiner takes Official Notice that metering content usage on a per use basis and associating the use with an identifier of a user is old and well-known in the art because this method reduces the cost to a user who may only want to use the content once.

- cc. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the managing means of Kent/Nii with the old and well-known metering method. One would have been motivated to do so because this would provide a convenience to the user and lower costs to access content.
24. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
25. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.
26. In light of Applicant's choice to pursue product claims, Applicants are reminded that functional recitations using the word and/or phrases "for", "adapted to", "configured to", or other functional language (*e.g.* claim 7 recites "an ordering unit configured to receive") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. This is an alternative argument because the functional limitations have been found in the prior art. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is

capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

27. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.<sup>3</sup> Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- dd. ***unit*** “(6)(C) (**software**) A software component that is not subdivided into other components. Note: The terms “module,” “component,” and “unit” are often used interchangeably or defined to be sub-elements of one another in different ways depending upon the context” [emphasis in original]. (IEEE 100 The Authoritative Dictionary of IEEE Standards Terms, 7<sup>th</sup> Edition, IEEE, Inc., New York, NY, Dec. 2000); and
- ee. ***genre*** “1. A type or class.” (The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000).

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<sup>3</sup> While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

***Response to Arguments***

28. Applicants' arguments with respect to claims 1-5 and 7-9 have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).

30. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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